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In re Application of
EATHERTON et al.
Application No. 10/528,592
PCT No.: PCT/EP03/10935
Int. Filing Date: 25 September 2003
Priority Date: 27 September 2002
Attorney Docket No.: P33117USW
For: PYRIDINE DERIVATIVES AS CB2
RECEPTOR MODULATORS

DECISION ON PETITION
UNDER 37 CFR 1.181

This decision is in response to applicant's "Petition for Withdrawal of Abandonment under 37 CFR 1.181" filed in the Patent and Trademark Office (PTO) on 17 August 2006. No petition fee is required.

BACKGROUND

On 25 September 2003, applicant filed international application no. PCT/EP03/10935 which claimed a priority date of 27 September 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 08 April 2004. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 27 March 2005.

On 21 March 2005, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, inter alia, the basic national fee; a copy of the international application; and a preliminary amendment.

On 17 November 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 04 August 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment indicating that the application was abandoned for failure to respond to the Notification of Missing Requirements mailed 17 November 2005.

On 17 August 2006, applicants filed the petition considered herein. The petition requests withdrawal of the holding of abandonment, stating that a response to the Notification Of Missing Requirements was timely filed via facsimile on 08 December 2005.

DISCUSSION

The present petition is accompanied by a document entitled "Response To Notification Of Missing Requirements Under 35 U.S.C. 371" that references an attached declaration, contains the authorization to charge Deposit Account No. 07-1392 the required surcharge, and bears a "Certificate of Transmission by Facsimile" dated 08 December 2005. The Certificate of Mailing, executed by Valerie L. Phillips, states that the accompanying materials were transmitted to the USPTO by facsimile. The petition also includes a copy of an executed declaration, and the confirmation report from applicants' facsimile machine.

The application file does not contain the materials purportedly filed by facsimile on 08 December 2005. In order to confirm the 08 December 2005 filing of the materials accompanying the present petition, applicants must satisfy the requirements set forth in 37 CFR 1.8(b), which states the following:

In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

Referring to the statement required by 37 CFR 1.8(b)(3), MPEP § 512 states the following: "If the person signing the statement did not sign the certificate of mailing, then the person signing the statement should explain how they have firsthand knowledge of the previous timely mailing or transmission."

The present petition, which is signed by J. Scott Young, states that the attached materials were submitted by facsimile on 08 December 2005. However, Mr. Young is not the person who executed the Certificate of Transmission, and he does not state "how he has firsthand knowledge of the previous mailing or transmission" as required by MPEP § 512; the petition does not include a confirming statement from Valerie L. Phillips (the person who executed the Certificate Of Mailing on the response materials). Based on the above, the present petition does not satisfy the requirement of 37 CFR 1.8(b)(3).

CONCLUSION

Applicants' petition to withdraw the holding of abandonment is **DISMISSED** without prejudice.

The application remains **ABANDONED**.

Any request for reconsideration must be submitted within **TWO (2) MONTHS** of the mail date of the present decision and must include the materials required to satisfy 37 CFR 1.8(b)(3), as discussed above.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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